

### REMARKS

Assignee thanks the Examiner for the indication of allowance of many claims and responds to the remaining objections and rejections. After entry and consideration of this paper, all claims should be in condition for allowance.

#### Response to Objections

In response to paragraph 1 of the Office Action, assignee submits formal drawings under separate cover.

In response to paragraph 21 of the Office Action, assignee corrects claim 49.

Assignee also amends claim 33 to correct a typographic error introduced in the last response.

#### Response to Section 101 Rejections

In response to paragraphs 2-7 and 9, which contain a rejection under 35 U.S.C. §101, assignee respectfully requests reconsideration. The Office Action asserts that the invention of claims 14, 15, 22-25, 45-52 would normally be considered statutory subject matter but are not in this case because the specification "defines 'data storage medium' as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived," specifically by defining "a 'data storage medium' as including software" in paragraph [0022] of the specification.

Assignee respectfully submits that the specification at paragraph [0022] does not "define" the term "data storage medium" to include intangible media. That paragraph mentions that the "functional modules" shown in FIG. 1 "can be suitably implemented by hardware, software, or both." Such statement does not define the term "data storage medium." The final sentence of that paragraph speaks of the "routes of interconnection" for functional modules to interact, and it identifies two possibilities, hardware and "access to shared storage media," plus combinations thereof. Both of those routes interconnections are tangible, by the way. The sentence uses, but does not define, the term "shared storage media." However, the sentence gives examples of "shared storage media," namely, "RAM media, dual-access RAM, files residing on hard disk media, etc." All of those examples (RAM, hard disk) are tangible media. Nowhere

does the paragraph define storage media as "software" as the Office Action contends. Accordingly, assignee respectfully requests reconsideration and withdrawal of the rejections under Section 101.

With specific reference to the Section 101 rejection of claims 15 and 25, aside from the issue with paragraph [0022] above, the Office Action asserts (paras. 5, 7) that the various "means" are "not tangibly embodied in a manner so as to be executable." Assignee respectfully requests reconsideration. First, the Examiner correctly notes that the "means" are not necessarily hardware. However, claims 15 and 25 have "means plus function" features, and Section 112(6) (and *In re Donaldson*; *In re Alappat*) clearly means that the Office must interpret those elements in accordance with the specification. MPEP 2106 at p. 2100-9 (8<sup>th</sup> ed. Rev. 2 May 2004). In paragraph 12 of the Office Action, the Examiner acknowledges this requirement (although assignee has not verified, and the Examiner may not have meant to imply, that the paragraphs given there are the only ones pertinent). For the "means" elements of claims 15 and 25, the specification clearly discloses several possibilities for the "means for identifying," "means for transmitting," and "means for causing": (1) Hardware embodiments, (2) software stored on tangible storage media, and (3) signals propagated on a carrier medium encoding programs. All of those are statutory subject matter. To avoid any doubt, assignee clearly disclaims any argument that the "means" of claims 15 or 25 encompass any software *per se*, i.e., without being stored on tangible storage media or propagated on a carrier medium.

The Section 101 rejection of claims 26-27 is somewhat different: These are "propagated signal" claims, and the Office Action states (para. 8) that they are "non-statutory as not being tangibly embodied in a manner so as to be executable." Assignee has made an appropriate amendment to overcome this rejection.

#### Response to Section 103 Rejections

In response to the obviousness rejection of claim 15 in paragraphs 10-15 and 31 of the Office Action, assignee respectfully requests reconsideration. As indicated above, claim 15 must be read as defined by the specification and equivalents, in accordance with Section 112(6). Accordingly, claim 15, part (a), "means for identifying addresses of

one or more recipients of the message and designating each recipient as having viewing or editing privileges of the file," must be interpreted as the specific "means for ... designating each recipient as having viewing or editing privileges" disclosed in the specification, i.e., using some kind of special designation, like (but perhaps not exactly the same as) the viewer and editor fields shown in the figures. The "means for designating" cannot be simply an ordinary (to, cc, or bcc) field, like Yamaguchi, that is defined to allow certain privileges, as that is neither disclosed in the present specification nor an equivalent thereof. As a result, the reasons for allowance provided in paragraph 24 of the Office Action apply equally well to the invention defined by claim 15, properly construed.

In response to the obviousness rejection of claims 29-33, 37, 38, and 49-52, in paragraphs 16-20 and 31 of the Office Action, assignee respectfully requests reconsideration. Independent claims 29 and 49 state:

(d) for each electronic message sent to a file accessor address authorized for direct file access, transmitting data of the file separately from the electronic message; and

(e) for each electronic message sent to a file accessor address not so authorized, transferring data of the file as an attachment to the electronic message.

Accordingly, in the claimed arrangement, file data are transmitted in two different ways depending on authorization.

In the Office Action, Yamaguchi is cited (paras. 17, 31) as disclosing transferring files as attachments, and Kuzma is cited (para. 19) as disclosing transferring files by hyperlink reference. The theory of the Office Action (para. 20) is that it would have been obvious to have substituted Kuzma's hyperlink reference for Yamaguchi's attachment-based file transfer.

However, neither Yamaguchi nor Kuzma disclose the claimed system of transmitting file data by attachment or separately from the email, depending on

Serial No. 09/915,719

Page 19 of 20

whether the addressee is authorized for direct file access. Neither reference, nor the references combined as the Office Action specifies, would have the claimed feature of transmitting file data in two different ways depending on authorization. Indeed, if the Office Action's stated motivation to apply Kuzma's teachings is accepted, the ordinarily skilled artisan would have been motivated to use Kuzma's hyperlink references instead of attachment-based file transfer in every case, even to addresses authorized for direct file access. Such a system would similarly be distinct from the rejected claims.

The combination of Yamaguchi and Kuzma do not meet the specified features of the three rejected independent claims. Accordingly, assignee respectfully requests that the Office reconsider and withdraw the rejections of each of the claims based on that combination. Assignee respectfully requests that the application be allowed.


If the Examiner has any questions, please feel free to contact assignee's undersigned attorney.

Respectfully submitted,

TACIT NETWORKS, INC.

by its attorney

Dated: November 2, 2005

---

Louis J. Hoffman  
Reg. No. 38,918

LOUIS J. HOFFMAN, P.C.  
14614 North Kierland Boulevard  
Suite 300  
Scottsdale, Arizona 85254  
(480) 948-3295